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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,533	12/30/2004	Markus Oles	263593US0XPCT	9525

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

WALTERS JR, ROBERT S

ART UNIT	PAPER NUMBER
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1792

NOTIFICATION DATE	DELIVERY MODE
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11/04/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No. 10/518,533	Applicant(s) OLES ET AL.	
	Examiner ROBERT S. WALTERS JR	Art Unit 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-27 and 30-38 is/are pending in the application.
- 4a) Of the above claim(s) 14-24,36 and 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-27,30-35 and 38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Application

Claims 14-27 and 30-38 are pending. Claims 14-24, 36 and 37 are withdrawn. Claims 25-27, 30-35 and 38 are presented for examination.

Response to Arguments

Applicant's arguments, see request for reconsideration, filed 8/5/2009, with respect to the rejection(s) of claim(s) 25-27, 30-35 and 38 under 35 U.S.C. 103(a) and 35 U.S.C. 112 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Glenn et al. (U.S. Pat. No. 6235683).

Claim Objections

Claim 38 is objected to because of the following informalities: The status identifier for claim 38 shows that this claim is withdrawn. However, the status identifier should show this claim as previously presented. Appropriate correction is required in any claim set presented in response to this action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 25-27, 30-35 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glenn et al. (U.S. Pat. No. 6235683).

I. Regarding claims 25-27, 30-34 and 38, Glenn teaches an aqueous surfactant-free suspension comprising an organic solvent, water, and a hydrophobic (column 4, lines 52-53), nanostructured particle wherein the particle is less than about 100 microns (note that overlapping

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ranges are *prima facie* evidence of obviousness, see column 5, lines 47-51), wherein the suspension comprises at least 50.01% by weight of water (see Example 1, treatment 3, column 9), and the hydrophobic particles consist of TRANSLINK 77 (see Example 1, treatment 3, column 9) and may also be other particles with hydrophobicity imparted by a treatment with alkylsilane (column 5, lines 5-41). Glenn teaches preparing this solution by suspending the nanostructure particles in an organic solvent miscible with water and having a boiling point less than 150 °C, and then mixing this with surfactant-free water to form the suspension (see Example 1, treatment 3, column 9). It should be noted that the term nanostructured particle is a broad term and would encompass any ridge or indentation in the nanoscale range on a particle and does not limit the claim to structures having a defined nanoscale texture on the surface of the particle. Glenn teaches that the particles that are preferably used are about less than 100 microns, and these particles, being minerals or treated minerals, would inherently not have a perfectly flat texture and would have imperfections that would correspond to ridges and indentations on the nanoscale range (corresponding to an irregular surface nanostructure with features in the range of 10 to 100 nm), thus reading on the claimed term of nanostructured particle and claim 34. Further, it should be noted that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, as in this case, the claim is unpatentable even though the prior product was made by a different process.

Glenn further teaches the suspension having 0.1 to 49.9% by weight of methanol (see Example 1, treatment 3, column 9) and at least 60% water (see Example 1, treatment 3, column

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9). Glenn also teaches the use of solvents other than methanol, such as acetone (column 8, lines 44-51) as well as teaching that the solution only consists of water, the nanoparticles and the organic solvent (see Treatment 3 of Example 1, column 9).

Glenn fails to teach the particle present in 0.01 to 1% by weight. First, it would have been obvious to one of ordinary skill in the art at the time of the invention that adjusting the concentration of the particulate materials would adjust the amount of particulate material applied to the plant. Furthermore, Glenn makes clear that the amount of particulate material needed varies depending on a number of factors (column 6, lines 20-29). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to choose the instantly claimed range for the concentration of the particulate material through process optimization, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. See *In re Boesch*, 205 USPQ 215 (CCPA 1980).

II. Regarding claim 35, Glenn teaches all the limitations of claim 25, but fails to explicitly teach that the particles are not agglomerated. However, Glenn does teach that the particles should be finely divided (column 5, lines 47-48). Therefore, based on this teaching, it would be obvious to one of ordinary skill in the art at the time of the invention to modify Glenn's suspension by ensuring that the particles are not agglomerated. One would have been motivated to make this modification as Glenn actually teaches the benefits of the particles being finely divided (see above).

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Conclusion

Claims 14-27 and 30-38 are pending.

Claims 14-24, 36 and 37 are withdrawn.

Claims 25-27, 30-35 and 38 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT S. WALTERS JR whose telephone number is (571)270-5351. The examiner can normally be reached on Monday-Friday, 8:00am to 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached on (571)272-1414. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Barr/
Supervisory Patent Examiner, Art Unit
1792

/ROBERT S. WALTERS JR/

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October 29, 2009

Examiner, Art Unit 1792